

### **Amendments to the Drawing**

The attached sheets of the drawing includes changes to Figures 1-3. The sheets replaces the original sheets with formal corrections.

In Figure 1 reference numeral 14 with a lead line to the arm was changed to reference 5 numeral 16.

In Figure 2 reference numeral 14 with a lead line to the arm was changed to reference numeral 16.

In Figure 3 reference numeral 58 with a lead line was added to identify the threads matably engageable with threads 60 of connector 32.

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Attachment: Replacement Sheets (3)

## **REMARKS**

### **Status of Prosecution**

Applicant filed the original application on October 10, 2003. The Examiner mailed a first, non-final office action on March 10, 2005. This paper is in reply to that office action.  
5 Applicant requests reconsideration and withdrawal of the rejections raised in that office action.

### **Amendments**

Except as expressly discussed below, any changes made to the Application were not made in reply to any rejection or other communication from the Examiner, but are made to improve the clarity, readability, or understanding of the application or a portion of the  
10 application that was changed. As is evident, none of the amendments was made to add new matter, and none was made to narrow the scope of the claims. Indeed, all amendments were made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

### **In the Drawing**

15 In Figure 1 reference numeral 14 with a lead line to the arm was changed to reference numeral 16; in Figure 2 reference numeral 14 with a lead line to the arm was changed to reference numeral 16; and in Figure 3 reference numeral 58 with a lead line was added to identify the threads matably engageable with threads 60 of connector 32.

### **20 Examiner's General Objections and Rejections**

Claims 1-25 are pending.

In the Office Action, the Examiner rejected claims 1-25.

On pages 2-3 the Examiner objected to drawing informalities. In reply, Applicant has enclosed corrected formal drawings Figures 1-3 annotated as "Replacement Sheets."

25 On page 4 the Examiner objected to a specification informality. In reply, Applicant has amended the specification to change reference numeral "14" to "16" on page 3, line 19, of the Application.

On page 4 the Examiner rejected claims 14-17 under 35 U.S.C. §112, first paragraph, an argument that Applicant respectfully traverses.

On page 4 the Examiner rejected claims 10 and 13 under 35 U.S.C. §112, second paragraph, an argument that Applicant respectfully traverses.

On pages 5-6 of the Office Action the Examiner rejected claims 1-9, 11-13 and 19 under 35 U.S.C. §102(b), stating that those claims were anticipated by U.S. Patent No. 4,057,884 issued on November 15, 1977 to Suzuki (“Suzuki Patent”), an argument that Applicant respectfully traverses.  
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On page 7 of the Office Action the Examiner rejected independent claim 18 under 35 U.S.C. §103(a), stating that claim 18 is obvious over the Suzuki Patent”), an argument that Applicant respectfully traverses.

10 On pages 7-8 of the Office Action the Examiner rejected independent claim 20 and dependent claim 21 under 35 U.S.C. §103(a), stating that those claims were obvious over the Suzuki Patent in view of U.S. Patent 6,279,919 issued August 28, 2001 to Turos (“Turos Patent”), an argument that Applicant respectfully traverses. The inventor in connection with the Turos Patent and the Application under examination are the same.

15 On page 8 of the Office Action the Examiner rejected dependent claims 22-25 that depend from independent claim 20 under 35 U.S.C. §103(a), stating that those claims are obvious over the Suzuki Patent in view of the Turos Patent in further view of U.S. Patent No. 1,435,288 issued on October 10, 1921 to Gifford, *et al.* (“Gifford Patent”), an argument that Applicant respectfully traverses.

20 **Rejection Under 35 U.S.C. §112/1**

On page 4 the Examiner rejected claims 14-17 under 35 U.S.C. §112, first paragraph, an argument that Applicant respectfully traverses.

The Examiner states that it is not clear how the invention will pivot of the bore of the swivel member is threaded. The Merriam-Webster Dictionary (electronic version) states that  
25 “pivot” means to “turn.” Applicant respectfully submits that a component that turns in a bore that is threaded therefore pivots. In addition, “a connector is provided for rotatable insertion through the bores and the hole for rotatable and removable connection of the swivel member and the arm.” See Application, page 1, lines 26-28.

Applicant respectfully urges, therefore, that the rejection of claims 14-17 be withdrawn.

### **Rejection Under 35 U.S.C. §112/2**

On page 4 the Examiner rejected claims 10 and 13 under 35 U.S.C. §112, second paragraph, an argument that Applicant respectfully traverses.

5 The Examiner states that it is unclear what Applicant considers to be the “keeper.” The Applicant has explained the keeper as follows in the Application, page 2, lines 7-14:

10 As used in this document, the term “attitude” means the positioning of the cutter in relationship to a surface of a workpiece to be shaped during operation. Thus, the arm of the shaping tool is removably mountable on a device for positioning the shaping tool to perform shaping work on a rotating workpiece (collectively, a “keeper”). The keeper is positionable adjacent an arbor, and allows a craftsman to insert the end of the swivel member holding the cutter within a rotating workpiece such as a brake drum to perform the shaping work. The shaping tool may be locked into variable desired positions and attitudes during operation.

15 Applicant respectfully urges, therefore, that the rejection of claims 10 and 13 be withdrawn.

20 The Examiner also states that, regarding dependent claim 13, it is not clear what Applicant means by the term “substantially dimensionally equivalent.” In response, Applicant notes that claim 13 recites not only that the holes in the tongue are substantially dimensionally equivalent, but also that the holes are dimensionally equivalent to the opposing bores in the plurality of bar extension. (Emphasis added.) See Application, page 9, lines 23-25. Thus, the dimensions of the holes and the dimension of the bores are substantially equivalent.

25 Applicant respectfully submits, therefore, that claim 13 satisfies the threshold requirements of clarity and precision mentioned in MPEP §2173.02. While, on reflection, Applicant might agree that there are many ways to explain the dimensional equivalency, Applicant believes the phrase as used meets the threshold requirements of clarity and precision.

Applicant respectfully urges, therefore, that the rejection of claims 13 be withdrawn.

### **Rejection Under 35 U.S.C. §102(b)**

30 On pages 5-6 of the Office Action the Examiner rejected claims 1-9, 11-13 and 19 under 35 U.S.C. §102(b), stating that those claims were anticipated by U.S. Patent No. 4,057,884 issued on November 15, 1977 to Suzuki (“Suzuki Patent”).

35 U.S.C. §102 (b) provides:

“A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....”

10 Applicant respectfully submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the present application in the United States.

Specifically, the Suzuki Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

15 A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference... The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

Contrary to the Examiner's suggestion that all elements are disclosed in the Suzuki Patent, a tongue as disclosed and claimed in the Application is not, so the rejections of at least independent claims 1 and 11 are unsupported, and therefore should be withdrawn.

Independent claim 1 claims a coupler. The term “coupler” is defined by Applicant as including “...a tongue formed in one end of the swivel member that is removably and rotatably mountable in the slot formed between the two bar extensions of the arm.” See Application, page 1, lines 14-21, emphasis added; see also dependent claims 2-3.

Also contrary to the Examiner's suggestion that all elements are disclosed in the Suzuki Patent, a hole formed in one end of the tongue is not, so the rejections of at least independent claims 1, 11, and 19 are unsupported and therefore should be withdrawn. See Application, page 1, lines 21-22, and page 3, lines 22-26.

In addition, contrary to the Examiner's suggestion that all elements are disclosed in the Suzuki Patent, a partially beveled edge formed in the trailing edge of the tongue for restricting

movement of the swivel member is not, so the rejection of at least independent claim 11 is unsupported, and therefore should be withdrawn. See also dependent claim 9.

Finally, contrary to the Examiner's argument that all elements are disclosed in the Suzuki Patent, a partially beveled edge formed in the trailing edge of the tongue for restricting movement of the swivel member is not, so the rejection of at least independent claim 19 is unsupported, and therefore should be withdrawn. Independent claim 19 is directed in part to a "means for locking the swivel member and cutter into a desired attitude during a shaping operation." MPEP §2111.01.I., citing the venerable case of *In re Donaldson*, 16 F3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), provides that when an element is claimed in means plus function language, the specification must be consulted to determine the structure corresponding to the function. The corresponding language for the means for locking is found in the Application at page 3, lines 28-30. The partially beveled edge is thus included in the means for locking. In addition, the term "attitude" in the means for locking claim element is defined on page 2 of the Application, lines 7-8. Accordingly, the rejection of at least independent claim 19 is unsupported, and therefore should be withdrawn.

The Examiner suggests that "the series of indexing recesses...spaced from each other" are "capable of adjustably positioning the swivel member...." See Office Action, page 5. The Suzuki Patent, however, confirms that the recesses are for incrementally indexing positions of the cutter (emphasis added), which is not comparable to adjustably positioning the coupler in Applicant's claims in any number of positions. Applicant's coupler is not limited to incrementally indexing positions by such indexing recesses. See, for example, the Suzuki Patent, column 2, lines 29-44: "For facilitating the indexing operation utilizing the adjusting and fixing screw 25 and the recesses 5...[t]he location of the recesses 5 and 6 is such that when one of the recesses is engaged by the ball 26, one of the recesses 5 is roughly aligned with the adjusting and fixing screw...."

Therefore, Applicant respectfully urges that the Suzuki Patent does not anticipate Applicant's invention, and that the rejections be withdrawn.

**First Rejection under 35 U.S.C. §103(a)**

On page 7 of the Office Action the Examiner rejected independent claim 18 under 35 U.S.C. §103(a), stating that claim 18 is obvious over the Suzuki Patent.

35 U.S.C. §103 provides:

- 5           (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10           Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

15           Applicant adopts and incorporates by reference the remarks made in connection with the rejections above.

20           Moreover, as stated in the MPEP, to establish a *prima facie* case of obviousness three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference; (2) a reasonable expectation of success; and (3) the cited reference must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....” Applicant respectfully submits that the Office Action does not establish *prima facie* obviousness in connection with those requirements.

25           The Examiner argues that “mere reversal of the essential working parts of a device involves only routine skill....” See Office Action, page 7. The Examiner added that the specification “gives no criticality to the claimed limitation....” See Office Action, page 7. Applicant presumes that the Examiner’s reference to a “claimed limitation” is related to the “mere reversal of essential working parts.”

30           Examiner’s “mere reversal” argument seems to suggest that Applicant is not entitled to claims to more than one embodiment of an invention. MPEP §608.01(m), however, contemplates claims of varying scope. Also, the Office Action points to no MPEP requirement for “criticality” of a “claimed limitation” as a condition precedent for describing and claiming an alternative embodiment. In addition, as noted by Professor Irving Kayton:

The recent Federal Circuit case law...makes it clear that disclosure of only one embodiment is a specification invites unduly narrow claim

construction....Instead, it is necessary to contemplate the full scope of the invention, draft claims that embrace the full scope of the invention, and support those claims with a specification describing multiple embodiments and multiple alternatives....

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See *Crafting & Drafting Winning Patents*, Patent Resources Group, Inc. (2003), Vol. 1, at page 2-105.

The Examiner also cites the case of *In re Einstein*, 8 USPQ 167 as the basis for the “mere reversal argument.” After considerable research, Applicant believes the correct citation is *In re Einstein*, 46 F2d 373, 18 C.C.P.A. 885, 8 USPQ 166 (1931) (emphasis added). Applicant submits that significant changes both in patent law and patent application prosecution rules have occurred since 1931, as well as since 1982 when the current Court of Appeals, Federal Circuit came into existence. In addition, Applicant respectfully submits that the *Einstein* case does not stand precisely for the proposition that “mere reversal of the essential working parts of a device involves only routine skill” in the context of alternative embodiments within an applicant’s application; the case was concerned with whether elements or components found in the application were obvious over two prior patents. It was in the context of referring to two different prior patents that the court said reversing working parts of “previously patented” devices may not have constituted an invention in 1931. *In re Einstein*, 46 F2d 373, at 374. Applicant therefore believes the case is inapplicable to the present circumstances.

For the Examiner to establish a *prima facie* case of obviousness under current law the examiner must identify in the record any source of information. *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999). It is not enough to assert that something is “well recognized” in the art unless that is accompanied by an indication of that assertion’s origins. Generalized claims about secondary references teach or what a skilled artisan might have been aware of does not meet the test for *prima facie* obviousness. See *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If the Examiner is suggesting that the alternative embodiment is “merely an obvious design choice,” the decision of *In re Debicza*k found that unsupported argument lacking in persuasion. *In re Debicza*k, 50 USPQ2d 1614 at 1618, citing *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

Therefore, Applicant respectfully urges that independent claim 18 is not obvious over the Suzuki Patent, and that the rejection should be withdrawn.

**Second Rejection under 35 U.S.C. §103(a)**

On pages 7-8 of the Office Action the Examiner rejected independent claim 20 and dependent claim 21 under 35 U.S.C. §103(a), stating that those claims are obvious over the Suzuki Patent in view of U.S. Patent 6,279,919 issued August 28, 2001 to Turos (“Turos Patent”). The inventor in connection with the Turos Patent and the Application under examination are the same.

35 U.S.C. §103 provides:

- 10           (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20           Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference Applicant’s remarks made in connection with the rejections above.

25           The Examiner asserts that “Suzuki teaches a tool with an arm, swivel member having a cutter as set forth in the above rejection.” Applicant presumes that the “above rejection” is the rejection of claim 18. Claim 18 was rejected on the basis of “mere reversal” of parts. As the Applicant understands the rejection, therefore, the Examiner asserts that Suzuki teaches the tool in claim 18. Applicant, however, respectfully submits that, as shown in the remarks above, the Suzuki Patent does not show the tool of claim 18. Applicant also asserts that, as shown in earlier arguments, the Suzuki Patent does not show what is shown and claimed in the Application.

30           Moreover, as stated in the above remarks, to establish a *prima facie* case of obviousness three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited

reference; (2) a reasonable expectation of success; and (3) the cited reference must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....” Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness.

5 Restated, there must be “some objective teaching in the prior art or...knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be  
10 solved.” *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). Nothing suggested in the secondary reference cited by the Examiner, however, or shown in the primary reference, satisfy those requirements.

15 As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

20 Additionally, all claim limitations must be considered, especially when missing from the alleged prior art. That is because 35 U.S.C. §103 is concerned with differences between the subject matter sought to be patented, and the alleged prior art, with the subject matter sought to be patented viewed as a whole. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (emphasis added).

Therefore, Applicant respectfully urges that independent claims 20 and 21 are not obvious over the Suzuki Patent in view of the Turos Patent, and that the rejections should be withdrawn.

### **Third Rejection under 35 U.S.C. §103(a)**

25 On page 8 of the Office Action the Examiner rejected dependent claims 22-25 that depend from independent claim 20 under 35 U.S.C. §103(a), stating that those claims are obvious over the Suzuki Patent in view of the Turos Patent in further view of U.S. Patent No. 1,435,288 issued on October 10, 1921 to Gifford, *et al.* (“Gifford Patent”).

35 U.S.C. §103 provides:

- 5           (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10           Applicant submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

15           Applicant adopts and incorporates by reference the remarks made in connection with the rejections above.

Because Applicant has distinguished the references cited by the Examiner, Applicant submits that the independent claims are allowable and, therefore, the dependent claims are also allowable.

20           In addition, Applicant respectfully traverses the arguments of the Examiner that the Suzuki Patent teaches what is shown and claimed in the Application. Applicant has shown immediately above that the Turos Patent cannot be combined analytically under 35 U.S.C. §103(a) with the Suzuki Patent because no *prima facie* case of obviousness has been satisfied: there is no showing that (1) there is a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) there is no suggestion of a reasonable expectation of success; and (3) the cited reference has been shown above to not teach or suggest all the claim limitations. The cited references do not “expressly or impliedly suggest the claimed invention....” See MPEP §706.02(j). Applicant respectfully submits that the Examiner has not established those requirements.

25           The Examiner argues that the Gifford Patent “teaches a tool having a rod/handle (11) having a hexagonal shape,” and concludes that it would have been obvious to combine the hexagonal shape with the Suzuki Patent and Turos Patent “for the purpose of providing ease of grip/handling.” Nothing stated in the Gifford Patent provides any reason for the hexagonal

shape. Also, "most if not all inventions arise from a combination of old elements... Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather..., there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant." See *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) (emphasis added). No such motivation, suggestion, or teaching is shown.

#### **Declarations Included with this Reply**

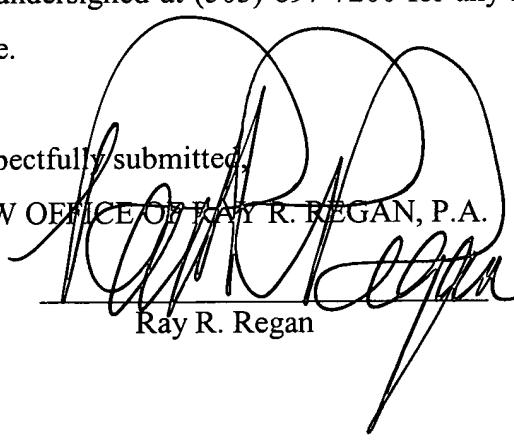
10 Consistent with the holding in *Graham v. John Deere, et al.*, courts have held that an unexpected advantage, property or utility of a claimed invention may overcome an assertion of obviousness. *Carter-Wallace, Inc. v. Otte*, 474 F.2d 529, 176 USPQ2d (CA 2, 1972); and *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

15 Accompanying this Reply, therefore, are two Declarations submitted under 37 C.F.R. §132 by an independent skilled person in the field of the technology, and by the inventor.

Applicant respectfully submits that this Reply and the Declarations establish that the references do not establish obviousness and request, therefore, that the rejections based on obviousness be withdraw.

#### **Conclusions**

20 For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims. Applicant respectfully asserts that this Reply is complete as contemplated in 37 CFR §1.111, that the rejected claims are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully requests an early notice of allowance. The Examiner is requested to call 25 the undersigned at (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted,  
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